

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

FISCHER *et al.*

Appl. No.: 10/578,497

§ 371(c) Date: April 2, 2007

For: **2-HALO-6-ALKYLPHENYL-
SUBSTITUTED TETRAMIC
ACID DERIVATIVES**

Confirmation No.: 1712

Art Unit: 1626

Examiner: CHU, Yong Liang

Atty. Docket: 2400.0300000/JMC/CMB

Reply to Restriction Requirement

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Office Action dated November 3, 2008, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group I represented by claims 1-5 and 8. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

The Office has also required Applicant to elect a single species for search purposes. Applicants provisionally elect compound I-a-4, on page 94 of the specification, as a single species.

This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made **with** traverse.

This application is a National Phase Entry Under 35 U.S.C. § 371 and, as such, PCT Rule 13 requiring unity of invention applies. Title 37 of the Code of Federal Regulations states:

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combination of categories: . . .

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; . . . 37 C.F.R. § 1.475 (b)(1)(2).

Elected Group I contains claims drawn to specific compounds, pesticides and/or herbicides and compositions of formula I. Group II is drawn to a process of preparing the compounds of Group I, and Group III is drawn to a process for preparing pesticides and/or herbicides comprising compounds of Group I. Group IV is drawn to a method of using the compounds of Group I. Groups I, II, III and IV therefore share unity of invention because the special technical feature common to all the claims in the groups is the compounds of Group I. Applicants therefore respectfully assert that the Groups I, II, III and IV share unity of invention and the Restriction Requirement is improper.

The Examiner has stated that a compound of formula (I) is not a special technical feature, because it fails to define a contribution over the prior art. Applicants respectfully disagree, and direct attention to section 1850 of the Manual for Patenting Examining Procedure, which states:

Although lack of unity of invention should be raised in clear cases, it should neither be raised nor maintained on the basis of narrow, literal, or academic approach. For determining the action to be taken by the examiner...rigid rules cannot be given and each case should be considered on its merits, *the benefit of any doubt being given to the applicant.* (emphasis added)

MPEP § 1850 (II)(paragraph 4).

The claims of the instant application do not qualify as a "clear case" of lacking unity of invention. Each claim shares the special technical feature of a compound of formula (I); a compound of formula (I) represents a contribution over the prior art. As stated above the benefit of *any* doubt with respect to unity of invention must be given to the applicant. Applicants therefore respectfully submit that a compound of formula (I) represents a special technical feature and unity of invention exists between the claims of Groups I, II, III and IV.

The Examiner has also argued that a compound of formula (I) is rendered obvious by U.S. Patent No. 5,142,065 (Fischer *et al.*). Applicants respectfully disagree, noting that a Restriction Requirement is not an Office Action on the merits, and thus, an obviousness rejection is improper. Furthermore, Applicants direct attention towards section 2143 of the Manual of Patenting Examining Procedure, which states:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reasons why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.
MPEP § 2143 (paragraph 1).

Applicants respectfully submit that the Examiner has neither articulated reasons why a compound of formula (I) would have been obvious, nor has the Examiner explicitly supported the analysis. Therefore, Applicants submit that the Examiner has not met the burden of proof required to establish a prima facie case of obviousness under 35 U.S.C. §103, and all such arguments should be withdrawn.

Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

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